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| APPLICATION NO.  | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|--|-------------|----------------------|---------------------|------------------|
| 09/753,074   | 12/29/2000  | Scott W. Atkinson    | 046700-5032         | 3499             |
| 28977  | 7590        | 12/16/2004           | EXAMINER            |                  |
| MORGAN, LEWIS & BOCKIUS LLP<br>1701 MARKET STREET<br>PHILADELPHIA, PA 19103-2921 |             |                      | HAMILTON, LALITA M  |                  |
|  |             |                      | ART UNIT            | PAPER NUMBER     |
|  |             |                      | 3624                |                  |

DATE MAILED: 12/16/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/753,074

Applicant(s)

ATKINSON ET AL.

Examiner

Lalita M Hamilton

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-30 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-30 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)               | Paper No(s)/Mail Date. ____   |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>12122004</u> .  | 6) <input type="checkbox"/> Other: ____                                     |

## **DETAILED ACTION**

### ***Claim Rejections - 35 USC § 101***

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1-24 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

35 USC 101 requires that in order to be patentable the invention must be a "new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof" (emphasis added).

Claims 1-24 are rejected under 35 U.S.C. 101 because; the claimed invention is directed to a non-statutory subject matter. Specifically the method claims as presented do not claim a technological basis in the pre-amble and the body of the claim. Without a claimed basis, the claim may be interpreted in an alternative as involving no more than a manipulation of an abstract idea and therefore non-statutory under 35 U.S.C. 101. In contrast, a method claim that includes in the body of the claim structural / functional interrelationship which can only be computer implemented is considered to have a technological basis [See Ex parte Bowman, 61 USPQ2d 1669, 1671 (Bd. Pat. App. & Inter. 2001) - used only for content and reasoning since not precedential].

In order to over come the 101 rejection above, the following preamble is suggested:

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-A computer implemented method for ---, or something similar. Also, in the body of the claim include structural / functional interrelationship which can only be computer implemented.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-30 are rejected under 35 U.S.C. 102(e) as being anticipated by Ausubel (6,026,383).

Ausubel discloses a method and corresponding system and computer-readable medium comprising forming a rule for a second auction round, conducting the first auction round, and conducting the second auction round in accordance with an application of the rule to an occurrence in the first auction round (col.3, line 1 to col.4, line 38 and col.8, line 1 to col.9, line 2; the occurrence includes an outcome of the first auction round (col.3, line 1 to col.4, line 38 and col.8, line 1 to col.9, line 2); auction in at least two rounds, wherein at least two bidders bid in the auction, forming a rule for a second auction round, conducting the first auction round, determining an outcome of the first auction round, applying the rule to the outcome of the first auction round, and

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conducting a second auction round in accordance with the applied rule (col.3, line 1 to col.4, line 38 and col.8, line 1 to col.9, line 2); the rule includes selecting at least two leading bidders from the first auction round (col.3, line 1 to col.4, line 38 and col.8, line 1 to col.9, line 2); the rule includes permitting only the at least two leading bidders to participate in the second auction round (col.3, line 1 to col.4, line 38 and col.8, line 1 to col.9, line 2); rule includes selecting a winning bidder from the first auction round (col.3, line 1 to col.4, line 38 and col.8, line 1 to col.9, line 2); the rule includes not permitting the winning bidder to participate in the second auction round (col.3, line 1 to col.4, line 38 and col.8, line 1 to col.9, line 2); forming a rule for a second auction round precedes conducting said first auction round (col.3, line 1 to col.4, line 38 and col.8, line 1 to col.9, line 2); the bidders are electronically coupled to an auction coordinator during the conducting of the first and second auction rounds (col.3, line 1 to col.4, line 38 and col.8, line 1 to col.9, line 2); the bidders submit bids to the auction coordinator online during the conducting of the first and second auction rounds (col.3, line 1 to col.4, line 38 and col.8, line 1 to col.9, line 2); the auction is a reverse auction (col.3, line 1 to col.4, line 38 and col.8, line 1 to col.9, line 2-may be any type of auction); the auction is a forward auction (col.3, line 1 to col.4, line 38 and col.8, line 1 to col.9, line 2); the bidders participate in a sealed bid in the first auction round and are electronically coupled to an auction coordinator online during the second auction round (col.3, line 1 to col.4, line 38 and col.8, line 1 to col.9, line 2); the rule includes permitting only bidders bidding less than a predetermined amount to participate in the second auction round (col.3, line 1 to col.4, line 38 and col.8, line 1 to col.9, line 2); conducting an auction in at

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least two rounds, determining that a bidder may participate in a subsequent auction round if that bidder has not been awarded a contract in a previous auction round, conducting a first auction round, awarding a contract to a bidder in the first auction round, and conducting a second auction round including only bidders that were not awarded a contract in the first auction round (col.3, line 1 to col.4, line 38 and col.8, line 1 to col.9, line 2); soliciting potential bidders (col.3, line 1 to col.4, line 38 and col.8, line 1 to col.9, line 2); soliciting potential bidders includes preparing a request for quotation, providing the request for quotation to potential bidders, and requesting that potential bidders respond to the request for quotation (col.3, line 1 to col.4, line 38 and col.8, line 1 to col.9, line 2); request for quotation includes an identification of goods to be purchased (col.3, line 1 to col.4, line 38 and col.8, line 1 to col.9, line 2); request for quotation includes an identification of services to be purchased (col.3, line 1 to col.4, line 38 and col.8, line 1 to col.9, line 2); awarding a contract to a bidder in the second auction round and conducting a third auction including only bidders that were not awarded a contract in the first auction round and bidders that were not awarded a contract in the second auction round (col.3, line 1 to col.4, line 38 and col.8, line 1 to col.9, line 2); determining that a bidder may participate in a subsequent auction round if that bidder is a leading bidder in a previous auction round, conducting a first auction round which includes a plurality of bidders, designating one or more of the plurality of bidders as non-leading bidders in accordance with the conducting of the first auction round, and conducting a second auction round that excludes the non-leading bidders from the first auction round (col.3, line 1 to col.4, line 38 and col.8, line 1 to col.9, line 2);

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conducting a third auction round including only leading bidders in the first round auction (col.3, line 1 to col.4, line 38 and col.8, line 1 to col.9, line 2); conducting a third auction round including only leading bidders in the second round auction (col.3, line 1 to col.4, line 38 and col.8, line 1 to col.9, line 2); a plurality of bidders may participate in a subsequent auction round (col.3, line 1 to col.4, line 38 and col.8, line 1 to col.9, line 2); a sponsor processor, a first bidder processor communicating with said sponsor processor, and a second bidder processor communicating with said sponsor processor, wherein said sponsor processor contains instructions which, when executed by said processor cause said processor to conduct a first auction round, apply a rule to an occurrence in the first auction round, and conduct a second auction round in accordance with the applied rule (col.3, line 1 to col.4, line 38 and col.8, line 1 to col.9, line 2); first bidder processor and said second bidder processor communicate through an auction coordinator during the first and second auction rounds (col.3, line 1 to col.4, line 38 and col.8, line 1 to col.9, line 2); and first bidder processor and said second bidder processor communicate through the Internet during the first and second auction rounds (col.3, line 1 to col.4, line 38 and col.8, line 1 to col.9, line 2).

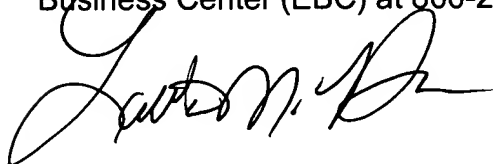
### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lalita M Hamilton whose telephone number is (703) 306-5715. The examiner can normally be reached on Tuesday-Thursday (8:30-4:30).

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vincent Millin can be reached on (703) 308-1065. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, appearing to read "L. M. H.", is written over the printed name "LMH".

LMH